

## **REMARKS**

Claims 1-8, 10-27 29-31, 33-41 and 48-52 are pending in the application, with Claims 9 and 42 being cancelled herein. Of these pending claims, Claims 19-22 and 48-52 are withdrawn from consideration, and Claims 1-18, 23-27, 29-31 and 33-42 are rejected. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **REJECTION UNDER 35 U.S.C. § 102**

Claim 42 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Bregenzer et al. (GB Application 2,065,011). Claim 42 has been cancelled.

Claims 1-3, 5 and 8-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by EP 1060826 A1. The Office Action states that the reference teaches a weldable ring fastener having a solid cylindrical body having an exterior thread portion, a web having a first head thickness that is greater than a second annular weldment area head thickness. Applicants respectfully traverse this characterization.

The Examiner's attention is directed to MPEP § 2125. The Federal Circuit has stated clearly and repeatedly that patent drawings may not be used to define the precise proportions of elements and may not be relied upon to show particular sizes if the specification is completely silent to the dimension. Recently, the Federal Circuit in overturning a finding of invalidity of a patent claim based on figures stated, "The district court erred in not properly applying the principles set forth in our prior precedents that arguments based on drawings not explicitly made to scale in the issued patents are unavailing." *Nystrom v. TREX Co.*, 76 USPQ2d 1481, 1491 (Fed. Cir. 2005). "[I]t is

well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” *Hockerson-Halberstadt*, 222 F.3d 951, 956 (Fed. Cir. 2000) (citing *In re Wright*, 569 F.2d 1124, 1127).

Similarly, in overturning a finding of invalidity by the USPTO, the Federal Circuit stated, “Absent any written description in the specification of quantitative values, arguments based on measurements of drawings are of little value.” *In re Wright*, 569 F.2d 1124, 1127. “Under the principles set forth in our prior cases, the speculative modeling premised on unstated assumptions in prior art patent drawings cannot be the basis for challenging validity of claims reciting specific dimensions not disclosed directly in such prior art.” *Nystrom v. TREX Co.*, 76 USPQ2d 1481, 1491 (Fed. Cir. 2005). As such, Applicants respectfully traverse the Examiner’s characterization of EP 1060826. Further, Applicants respectfully assert that the figures in this and the other cited references are not proportioned to be drawn to scale and are devoid of any such indication within their specification.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-12, 23-27 and 29-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Soyer (DE 4,222,664) in view of Arino et al. (U.S. Pat. No. 4,689,958). The Examiner claims the Soyer reference teaches all of the claim limitations except for the claimed thickness of the annular weldment area and a weakened point at the shank adjacent to the head. The Examiner further states that it would have been readily apparent that the threads would “strip” at a first failure load

which is much less than the load required for the head to shear. The Examiner further states that the shank has a smaller cross-sectional area making it more prone to shearing than the larger head/web portion.

Applicants assert that not only do the references fail to expressly teach the limitation but, as described above, the patent figures cannot be used to infer any dimensional relationships not expressly disclosed in the application. As such, Applicants assert that it is improper for the Examiner to take any inference as to any of the dimensions related to the figures in 4,689,958 or DE 4222664. With respect to the use of such measurements in an obviousness rejection, the Federal Circuit specifically rejected a holding that stated that the correct inquiry is whether a person of ordinary skill in the art would use measurements from a reference to ascertain a degree of curvature. *Nystrom v. TREX Co.*, 76 USPQ2d 1481, 1490 (Fed. Cir. 2005). In rejecting the District Court's analysis, the Federal Circuit stated, "The basis for the district court's summary judgment of invalidity was a model that TREX developed based on that reference, and not on drawing dimensions or written disclosure of dimensions contained in the patent itself. Under the principles set forth in our prior cases, the speculative modeling premised or unstated assumptions in prior art patent drawings cannot be the basis for challenging the validity of claims reciting specific dimensions not disclosed directly in such prior art." *Nystrom v. TREX Co.*, 1491 USPQ2d 1481, 1491 (Fed. Cir. 2005).

Claims 14-18, 31, and 33-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Soyer, in view of Arino et al. and Bregenzer et al. The Office Action states that the reference fairly suggests the limitations found in Claims 1-12, 23, 27, 29 and 30. Applicants traverse this characterization for the aforementioned reasons.

Similarly, Applicants traverse the rejection of Claims 14-18, 31, 33-42 for the reasons discussed above.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Soyler in view of Arino et al. and further in view of Bidefeld (U.S. Pat. No. 5,054,980). While Applicants believe the Examiner has not met his burden to create a prima facie case of obviousness, Applicants have amended Claim 13 as suggested to expedite prosecution.

Claims 6, 7, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 1060826 A1. Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 1060826 A1 in view of Bidefeld. Claims 14-18, 31 and 33-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 1060826 A1 in view of Bregenzer et al. For the afore discussed reasons, Applicants submit that the references are completely silent as to the dimensional claim limitations as well as the failure strength limitations. As such, Applicants assert the Examiner has not met the requisite showings to reject these claims under 35 U.S.C. § 103.

Claims 1-4, 6-18, 23, 25, 26, 27, 29-31 and 33-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 03/004883 to Kortmann in view of Bregenzer et al. The Examiner states that this reference suggests a weld stud and stud to structure combination comprising every structural element contained in Claims except for the relative size and dimensions. The Examiner further states "Although it appears the reference is silent about relative failure loads, it would be apparent to those of ordinary skill, that these are limitations inherent to the WO 03/004883 disclosure." Applicants strongly traverse this characterization. Applicants respectfully assert that, as

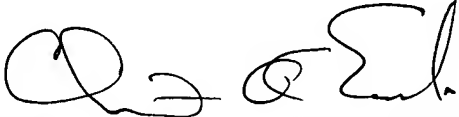
admitted by the Examiner, this particular reference is completely silent as to the dimensional limitations of each of these claims. Additionally, as admitted by the Examiner, this reference is completely silent as to the respective failure loads for each of the elements as claimed. Further, the Examiner has offered no showing that the failure loads of the claimed invention are inherent in the cited reference. To the extent the Examiner is attempting to take notice to the inherency of these properties, Applicants respectfully traverse and request further support be provided.

#### CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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